

**REMARKS**

Claims 1-30, 32-38 and 40 remain pending in the application. The undersigned representative wishes to thank the Examiner (and Examiner Hayes) for conducting an interview on October 17, 2006, to discuss the application of the cited Jones, Sepetka, and Ferrera references to the claims of the present application. In view of the agreement (in part) reached during the interview, and further based on the foregoing claim amendments and following remarks, reconsideration and allowance of the application is respectfully requested.

**Objection to the Specification**

Claim 18 has been amended to now correctly state “between 110% and 200%,” which is consistent with paragraph 51 on page 18 of the original specification, as filed. In view of this correction to claim 18, the objection to the specification is believed overcome.

**Objection to the Drawings**

The drawings have been amended to include element No. 30, which had been inadvertently omitted from original Figure 1. No new matter has been added. Applicant is concurrently submitting a replacement sheet of the drawing to the Patent Office, including this change. Applicant respectfully requests that amendment to Figure 1 be entered.

**Claim rejections – 35 U.S.C. §112**

Claim 27 has been amended to overcome the rejection under §112. Although it was not rejected under §112, claim 38 has been similarly amended. Claim 31 has been canceled.

**Claim Rejections - 35 U.S.C. §102**

Claims 1, 2, 4-8, 14-18, 24, 28-30, 32-33, 36 and 40 stand rejected under 35 U.S.C. §102(e), as allegedly being anticipated by USP 6723108 (“Jones”). Although there was no specific agreement reached on Jones at the interview, each of the independent claims 1, 30, 32 and

40 have been amended to more clearly point out that the active element (claims 1, 32 and 40) and hydrogel member (claim 30) has a pre-deployment configuration that is carried entirely within the lumen *with no portion of the pre-deployed active element located outside of the lumen*. As was pointed out by the undersigned at the interview, this configuration allows the claimed occlusive device to be deployed through a conventional delivery catheter, since the active element does not add any additional outer profile (i.e., diameter) to the occlusive device.

In contradistinction, Jones discloses (e.g., in Figs. 2A-B) an occlusive coil 20 that is embedded in a foam sleeve 22. In each of the embodiments of Jones, the foam sleeve extends both within and outside of the coil lumen, which requires that the delivery catheter have a greater inner lumen diameter (clearly shown in Fig. 1 of Jones), than is otherwise needed to accommodate the coil. Given the amended claim language, Applicant respectfully submits that the Examiner's speculation that the portion of the foam sleeve 22 that is located within the coil lumen (shown in Fig. 2B of Jones) may somehow be a "different" member than the portion of the foam sleeve 22 located outside of the coil lumen - speculation that Applicant does not agree with, and for which there is no support in Jones, since the foam sleeve is described as a single element, not as multiple elements.

For the same reason that independent claims 1, 30, 32 and 40 are now believed to clearly define patentable subject matter over Jones, dependent claims 2, 4-8, 14-18, 24, 28-29, 33 and 36 are also believed patentable over Jones, and Applicant respectfully requests that the claim rejections over Jones be withdrawn.

Claims 1, 6, 14-16, 30, 32 and 34 were rejected in the Office Action under 35 U.S.C. §102(e), as allegedly being anticipated by US Pub 2002/0169473 ("Sepetka"). However,

agreement was reached at the interview (as documented in the interview summary) that the present claims distinguish from Sepetka, and that this rejection would be withdrawn.

Claims 1, 2, 4-6, 10, 12, 14-17, 19-20 and 40 stand rejected under 35 U.S.C. §102(c), as allegedly being anticipated by USP 6,616,617 (Ferrera). Independent claims 1 and 40 have been amended to more clearly point out that the occlusive member defines a longitudinal axis and having an elongate axial lumen, and that the active element is carried in this lumen. As was discussed at the interview, this amendment is believed to clearly distinguish the claimed device from the embodiment of Fig. 10 of Ferrera, in which an putative “active element” 48 is positioned within a “lumen” (according to the Examiner) formed by a group of elongate members 42, 42, which in turn collectively form a strand wound into a primary helical winding.

For the same reason that independent claims 1 and 40 are now believed to clearly define patentable subject matter over Ferrera, dependent claims 2, 4-6, 10, 12, 14-17 and 19-20 (which all depend from claim 1) are also believed to be patentable over Ferrera, and Applicant respectfully requests that the claim rejections over Ferrera be withdrawn.

#### **Claim Rejections - 35 U.S.C. §103**

Claims 7-11, 17-18, 21-29, 31-32 and 34-39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sepetka in view of US Pub 2001/0046518 (Sawhney). Claims 9-11, 21-23, 25-27, 31, 34-35, 37 and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones in view of Sawhney. Claims 12 and 13 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones *and* Sepetka in view of Sawhney and in further view of USP 6,953,465 (Dieck). Finally, claim 3 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jones. Thus, each of the claim rejections under §103 are based at least in part on Sepetka or Jones.

However, in view of the Examiner's agreement at the interview on October 17, 2006, that Sepetka does not, in fact, read on the pending claims of the application, it is believed that the rejections under §103 based even in part on Sepetka will be withdrawn by the Examiner. And, in view of the above-discussed amendments made to each of the independent claims 1, 30, 32 and 40, it is believed that the rejections under §103 based even in part on Jones are also overcome for the same reason as the §102 rejections.

**USP 6,193,728 to Ken et al ("Ken").**

During the interview, the Examiner raised the possibility that Ken may anticipate or otherwise render obvious those claims of the present application in which the active element is not limited to a hydrogel. The undersigned representative has now read Ken from top to bottom, and is unable to find any specific teaching that the stretch resistant member in Ken (e.g., member 108 in Figs. 1A and 1B) contracts or expands in-situ to thereby cause the occlusive member (claims 1 and 40) or occlusive coil (claims 30 and 32) to retain its shape (claims 1, 30 and 32) or stiffen (claim 40). While there is mention in Ken that the stretch resistant member may be heat set, this does not in itself mean that it will *expand* or *contract* (as opposed to taking a secondary shape) in situ. The undersigned welcomes a telephone call from the Examiner if it would be helpful to better understand the basis of any possible application of Ken to the present claims.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests a notice of allowance. If there are any questions concerning this amendment and response, please contact the undersigned at the number below.

Respectfully submitted,  
VISTA IP LAW GROUP LLP

Dated: \_\_\_\_\_

11/1/06

By: \_\_\_\_\_

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FIG. 1

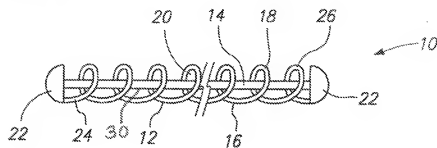


FIG. 2

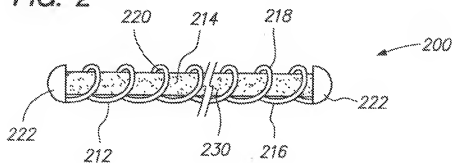


FIG. 3

